

**REMARKS**

Claims 1-8, 10-32, 34-46, 48, 50 and 52-59 are pending in the present application.

In the above amendments, claims 2-5, and 7 have been amended. New claims 52, 53 and 54 are similar to claims 1, 3 and 4, respectively with a new limitation added. New claims 55-59 again present claims 9, 33, 47, 49 and 51, respectively, which were previously canceled without prejudice.

***Claim Rejections – 35 USC § 102***

Claims 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Jamal (U.S. Patent No. 5,754,537). In a former Office Action, claims 52-59 (as claims 9, 33, 47, 49 and 51) were rejected as being anticipated by the Jamal patent.

The rejection of independent claim 10 as allegedly anticipated by the Jamal patent is respectfully traversed. Claim 10 recites a remote station that includes “a receiver for receiving one or more common grant channels from a base station and for receiving a busy signal from the base station” and “a transmitter for transmitting the access request message and for transmitting a portion of data from the data buffer in response to a decoded access grant in accordance with the received busy signal”. The Jamal patent discloses a method and system for transmitting background noise information on a packet reservation multiple access radio channel. In the Office Action, the examiner asserts that the Jamal patent teaches a remote station comprising “a receiver for receiving one or more common grant channels from a base station and for receiving a busy signal from the base station (see Fig. 6)” (emphasis added). See, Office Action, page 2. The examiner also asserts that the Jamal patent teaches “a transmitter for transmitting the access request message and for transmitting a portion of data from the data buffer in response to the decoded access grant in accordance with the received busy signal, wherein the receiver further receives one or more individual grant channels from the base station (column 11, lines 32-34; column 11, lines 57-63)” (emphasis added). See, Office Action, pages 2-3. Applicant’s representative is unable to find any disclosure in the Jamal patent related to “receiving a busy signal from the base station”, or related to “transmitting . . . in accordance with the received busy signal”. Accordingly, Applicants respectfully assert that claim 10 defines a patentable advance

over the Jamal patent, and the rejection of claim 10, under 35 U.S.C. § 102(b), is improper and should now be withdrawn.

The rejection of independent claim 11 as allegedly anticipated by the Jamal patent is respectfully traversed. Claim 11, (similar to claim 10) recites a remote station that includes “a receiver for receiving one or more common grant channels from a base station and for receiving a busy signal from the base station” and “a transmitter for transmitting the access request message and for transmitting a portion of data from the data buffer in response to a decoded access grant in accordance with the received busy signal”. The Jamal patent discloses a method and system for transmitting background noise information on a packet reservation multiple access radio channel. In the office action, the examiner asserts that the Jamal patent teaches a remote station comprising “a receiver for receiving one or more common grant channels from a base station and for receiving a busy signal from the base station (see Fig. 6)” (emphasis added). See, Office Action, page 3. The examiner also asserts that the Jamal patent teaches “a transmitter for transmitting the access request message and for transmitting a portion of data from the data buffer in response to the decoded access grant in accordance with the received busy signal, wherein the transmitter further transmits a limited portion of data in the data buffer autonomously, irrespective of whether an access grant has been received, respective to the busy signal (column 11, lines 32-34; column 11, lines 57-63)” (emphasis added). See, Office Action, page 3. Applicant’s representative is unable to find disclosure in the Jamal patent related to “receiving a busy signal from the base station”, or related to “transmitting . . . in accordance with the received busy signal”.

Further, claim 11 recites “wherein the transmitter further transmits a limited portion of the data to the data buffer autonomously, irrespective of whether an access grant has been received, responsive to the received busy signal.” However, with respect to method claim 35, which has features similar to claim 11, the examiner recognizes that “the prior art of record does not teach transmitting a limited portion of the data to the data buffer autonomously, irrespective of whether an access grant has been received, responsive to the received busy signal.” See, page 10. Thus, the rejection of claim 11 is inconsistent with the finding that the prior art of record fails to disclose the features of claim 35, which are similar to the features recited in claim 11.

Accordingly, Applicants respectfully assert that claim 11 defines a patentable advance over the Jamal patent, and the rejection of claim 11, under 35 U.S.C. § 102(b), is improper and should now be withdrawn.

***Claim Rejections – 35 USC 103***

Claims 1-2 and 5-8 are rejected under 35 USC 103(a) as being unpatentable over the Jamal patent in view of Scholefield (U.S. Patent No. 5,752,193). Claims 15-21 and 39-45 are rejected under 35 USC 103(a) as being unpatentable over the Jamal patent in view of Chen (U.S. Patent No. 5,923,650).

The rejection of independent claim 1 as allegedly unpatentable over the Jamal patent in view of the Scholefield patent is respectfully traversed. Claim 1 recites an apparatus that includes “a scheduler . . . for generating a busy command in response to the measure utilization” and “a transmitter . . . for transmitting a busy signal comprising one or more busy commands.<sup>1</sup> Similar to the argument made above with respect to claim 10, Applicant’s representative is unable to find disclosure in the Jamal patent related to “transmitting a busy signal comprising one or more busy commands”. Further, the Scholefield patent fails to remedy the disclosure deficiencies of the Jamal patent.

In addition, Applicants respectfully assert that the rejection of claim 1 fails to adequately address motivation to combine the referenced patents. The teachings of references can be combined only if there is some motivation or suggestion to do so. *In re Fine*, 837 F.2d, 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). In the Office Action, the Examiner merely concludes that “[o]ne of ordinary skill in the art would have been motivated to incorporate a scheduler into the communication network in order to be able to allocate resource.” See, Office Action, page 5. The showing of motivation to combine references is an essential component of an obviousness holding, and the factual inquiry of whether to combine references must be thorough, searching, and based on objective evidence of record. *See, In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Further, reliance on conclusory statements related to motivation to combine references without setting forth the rationale on which the conclusory statements rely violates the agency obligations under the Administrative Procedure Act. *Id.* Applicants asserts that the stated rejection fails to make the requisite showing of motivation to combine the cited

references, and to set forth the objective evidence of record supporting the showing of motivation to combine the references.

For these reasons, claim 1 defines a patentable advance over the Jamal and Scholefiled patents. Accordingly, the rejection of claim 1, under 35 U.S.C. § 103(a), is improper and should now be withdrawn.

Claims 2 and 5-8 have been amended to depend on new independent claim 52, and should now be allowed.

The rejection of independent claim 15 as allegedly unpatentable over the Jamal patent in view of the Chen patent is respectfully traversed. Similar to claim 10, claim 15 likewise recites a remote station that includes “a receiver for receiving one or more common grant channels from a base station and for receiving a busy signal from the base station” and “a transmitter for transmitting the access request message and for transmitting a portion of data from the data buffer in response to a decoded access grant in accordance with the received busy signal for call recovery by a wireless mobile station” (emphasis added). As noted above with respect to claim 10, Applicant’s representative is unable to find disclosure in the Jamal patent related to “receiving a busy signal from the base station”, or related to “transmitting . . . in accordance with the received busy signal”. Further, the Chen patent fails to remedy the disclosure deficiencies of the Jamal patent.

In addition, Applicants respectfully assert that the rejection of claim 15 fails to adequately address motivation to combine the referenced patents. The teachings of references can be combined only if there is some motivation or suggestion to do so. *In re Fine*, 837 F.2d, 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). In the Office Action, the Examiner merely concludes that “[o]ne of ordinary skill in the art would have been motivated to incorporate transmission rate decrease into the communication network in order to be able to reduce data overflow.” See, page 6. The showing of motivation to combine references is an essential component of an obviousness holding, and the factual inquiry of whether to combine references must be thorough, searching, and based on objective evidence of record. See, *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Further, reliance on conclusory statements related to motivation to combine references without setting forth the rationale on which the conclusory statements rely violates the agency obligations under the Administrative Procedure Act. *Id.*

Applicants asserts that the stated rejection fails to make the requisite showing of motivation to combine the cited references, and to set forth the objective evidence of record supporting the showing of motivation to combine the references.

For these reasons, claim 15 defines a patentable advance over the Jamal and Scholefiled patents. Accordingly, the rejection of claim 15, under 35 U.S.C. § 103(a), is improper and should now be withdrawn.

The rejections of claims 16 and 17, which depend on independent claim 15, as allegedly unpatentable over the Jamal patent in view of the Chen patent are respectfully traversed. In addition to the particular features recited in claims 16 and 17, the claims include the features recited in independent claim 15, but not disclosed or suggested by the Jamal patent in view of the Chen patent. Accordingly, for these reasons and the reasons recited with respect to independent claim 15, dependent claims 16 and 17 define a patentable advance over the Jamal patent in view of the Chen patent, and the rejections of claims 16 and 17, under 35 U.S.C. § 103(a), should be withdrawn.

The rejections of claims 18-21 and 39-45 as allegedly unpatentable over the Jamal patent in view of the Chen patent are respectfully traversed. In addition to the particular features recited each claim, these claims include the features similar to those recited in independent claim 15, but not disclosed or suggested by the Jamal patent in view of the Chen patent. Accordingly, for these reasons and the reasons recited with respect to independent claim 15, claims 18-21 and 39-45 define a patentable advance over the Jamal patent in view of the Chen patent, and the rejections of claims 18-21 and 39-45, under 35 U.S.C. § 103(a), should be withdrawn.

#### *Newly Added Claims*

New claim 52 is similar to claim 1 with the added feature that the scheduler is “for generating a busy command when the measured utilization exceeds a predetermined threshold”. In the Office Action, the examiner recognized that “the prior art of record does not teach transmitting a busy signal when the measured utilization exceeds a predetermined threshold.” See, page 10. Accordingly, new claim 52 recites patentable features over the cited prior art and should be allowed.

New claims 55-59 correspond to canceled claims 9, 33, 47, 49 and 51, respectively, which claims were previously rejected as allegedly anticipated by the Jamal patent. Claims 9, 33, 47, 49 and 51 recited busy signal features similar to those recited in claim 10. For the reason given above with respect to claim 10, Applicants respectfully assert that claim 55-59 define patentable advances over the Jamal patent, and should be allowed.

*Allowable Subject Matter*

In the Office Action, claims 3 and 4 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In addition, claims 1-8, 22-32, 46, 48, and 50 were allowed.

Applicant thanks the Examiner for the indication of allowable subject matter.

Accordingly, dependent claims 3 and 4 have been rewritten in independent form.

**REQUEST FOR ALLOWANCE**

In view of the foregoing, Applicant submits that all pending claims in the application are patentable. Accordingly, reconsideration and allowance of this application are earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

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